

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 13-17 and 19-20 are rejected under 35 USC 103(a) over the U.S. patent to Krasznai et al in view of the U.S. published patent application to Lenkiewicz et al.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended Claim 13, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

In the dust-collection container in accordance with the present invention as defined now in Claim 13, there are two filling marks which correspondingly extend substantially parallel to the substantially perpendicular edges of the viewing window to form a cross, and words corresponding to the "maximum" are provided adjacent to each of the filling marks.

When the dust-collection container is designed in accordance with the present invention, the maximum filling level can be easily identified in two working positions, namely parallel and

perpendicular to the horizontal plane, which significantly improves a control over the dust box when vertical working planes are treated/worked on, as well as horizontal planes are treated/worked on, correspondingly.

The identifying marks/lines and cross provided on the dust-collection container in the applicant's invention make a special contrast within the viewing window to the dust inside the dust box, which unwillingly catches the eye of a user and informs him about the filling status of the container.

Turning now to the references applied by the Examiner, and in particular to the Kraszna reference, it is respectfully submitted that this reference disclosed a viewing window which however does not have any marks. The window may be recognized by a user only by chance. It is not suitable to attract the users attention and to inform him about the filling status. This is why the duct collection part of this reference can be often overloaded, because the unmarked window and what it is supposed to show will be ignored by a user of the power tool. This reference clearly does not disclose the new features of the present invention which are now defined in amended Claim 13.

The Lenkiewicz reference does not show two filling marks, but the device disclosed in the reference has only one mark which is line

143 under the word "Full". The second line which is oriented rectangularly to line 143 only indicates the recommended filling position, but does not have any information about the filling status along this line, for example if the container is oriented horizontally. Also, there is only one filling position-upright position and parallel to the "fill line" – to be filled until the line 143 is met by the filling level. The marks disclosed in the patent to Lenkiewicz is only needed during the loading of the container. Then after this, there is no need for any further attention to the filling status and the mark. Thus, it is believed to be clear that this reference also does not teach the new features of the present invention as defined in amended Claim 13.

The Examiner rejected the claims over the combination of the references. As explained hereinabove, the new features of the present invention as now defined in amended Claim 13 are not disclosed in the references. Therefore, a combination of the references would lead only to such a dust-collection container which would not include these features as well. In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified by introducing into them the specific features of the present invention which are now defined in amended Claim 13 and which were first proposed by the applicants. However, it is known that in order to arrive at a claimed

invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained hereinabove, the present invention provides for the highly advantageous results which cannot be accomplished by the devices disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of this it is respectfully submitted that Claim 13 as amended should be considered as clearly and patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 13, they shares its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,  
/Michael J. Striker/  
Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233